REMARKS/ARGUMENTS

This Amendment is prepared in response to an Advisory Action dated September 24, 2004. Applicant has cancelled claims 1-19 and 28 without prejudice. Claims 25 and 34 have been placed into independent form to include limitations from prior independent claims 19 and 28, respectively. Claims 20-24 and 26-27 now depend on claim 25. Claims 29-33 and 35-36 now depend on claim 34. Claims 37-57 have been added. Examination of the pending claims is respectfully requested.

§ 102 Rejections

In the Final Office Action, claim 1, 7, 10, 16, 19, 25, 28 and 34 were rejected under 35 U.S.C. §102(e) as being anticipated by Lawler (USP 5,758,259). In addition, claims 1, 2, 6, 9-11, 15, 18-20, 24, 27-29, 33 and 36 were rejected under 35 U.S.C. §102(e) as being anticipated by Wugofski (US 2003/0056216 A1). While claims 1, 10, 19 and 28 were rejected under 35 U.S.C. §102(e) as being anticipated by Wehmeyer (USP 5,867,226), this rejection is moot based on the cancellation of claims 1-19 and 28 without prejudice.

Applicant respectfully disagrees with the outstanding §102(e) rejections because a *prima facie* case of anticipation has not been established. As the Examiner is aware, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

With respect to claim 25, neither Lawler nor Wugofski describe the limitation of "maintaining relative statistics on one or more items related to the tuning event by preventing rollover of a count value through adjustment of the count value upon the count value reaching a predetermined value and being reset when the count value is next incremented." Most notably, Lawler is directed to a "least recently used" (LRU) substitution technique for a viewer preference table as set forth on column 8, lines 5-44 of Lawler. *See page 8 of the Final Office Action.* The least recently used (LRU) substitution technique as applied to the viewer preference table (Table 2) does not constitute an operation that prevents rollover. In fact, the LRU substitution technique of Lawler would be highly susceptible to rollover conditions where a count value reaches a maximum value and rolls over to effectively reset the count value.

The absence of any express or inherent discussion of rollover within Lawler should not be construed as teaching the prevention of rollover. Otherwise, it would, in effect, be the position of the USPTO that all prior art references that do not describe the prevention of "rollover" should be considered as anticipatory.

With respect to claim 34, neither Lawler nor Wugofski describe the limitation of "a receiver coupled to the display and to store relative statistics, to detect a tuning event, to maintain the relative statistics related to a plurality of items of the tuning event, to prevent rollover of a

count value by automatically adjusting the count value of each of the plurality of items relative to each other so that an order of the plurality of items according to count value remains intact, and to create automatically a list of favorites based on the relative statistics in the memory." In fact, as stated above, the LRU process of Lawler fails to teach a technique to prevent rollover and describes a process that is susceptible to rollover, thereby teaching away from the claimed invention.

In light of the foregoing, withdrawal of the §102(e) rejection as applied to pending claims 25 and 35 as well as those claims dependent thereon is respectfully requested.

§ 103 Rejections

Claims 3, 12, 21 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Wugofski in view of Perlman (USP 5,583,576), (ii) Lawler in view of Perlman, and (iii) Wehmeyer in view of Perlman. Claims 4, 13, 22 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Wehmeyer in view of Levitan (USP 5,534,911), (ii) Wugofski in view of Levitan, and (iii) Lawler in view of Levitan. Claims 5, 14, 23 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Lawler in view of Towell (USP 6,647,411) and (ii) Wugofski in view of Towell. Claims 8, 17, 26 and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Wugofski in view of Zahavi (USP 5,410,367), (ii) Wehmeyer in view of Zahavi, and (iii) Lawler in view of Zahavi. Applicant respectfully traverses these rejections in their entirety and respectfully submits that these rejections are moot based on the cancellation of claims 1-19 & 28, placement of claims 25 & 34 into independent form including additional limitations, and the change of dependency for claims 20-24, 26-27, 29-33 and 35-36. Withdrawal of the outstanding §103(a) rejections is respectfully requested.

With respect to newly added claims 37-57, Applicant respectfully requests the Examiner to examine these claims and invites the Examiner to contact the undersigned attorney for discussion of these claims if such discussion will facilitate prosecution of the subject application. The undersigned attorney can be reached at the telephone number listed below.

Conclusion

At the Examiner's earliest convenience, Applicant respectfully requests withdrawal of the outstanding rejections and issuance of a Notice of Allowance.

Respectfully submitted,

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